

## **REMARKS**

This paper is filed in response to the Office Action dated July 12, 2004, setting a one-month period to respond. As this paper is filed on August 12, 2004, the paper is timely filed.

### **I. Status of Amendments**

Claims 45-88 were pending prior to this response. No amendments are made by this response. Thus, claims 45-88 remain pending.

### **II. Response to the July 12 Office Action**

In the July 12 Office Action, claims 45-88 were withdrawn from consideration as “directed to an invention that is independent or distinct from the invention originally claimed.” The specific basis is given as:

Claims 1-44 were directed to a method of conducting a gaming activity and a gaming machine upon which to practice the method. Claims 45-88 are directed to a method of operating an apparatus and the apparatus. There is a significant difference in the scope of the two inventions – the claims appear to be directed to two different games. In particular, claims 1-44 require generation and display of a partial outcome. Claims 45-88 contain no such requirement.

Applicant respectfully disagrees.

Initially, as to the first allegation that claims 1-44 were directed to a gaming method and gaming machine and that claims 45-88 are directed to a method of operating an apparatus and the apparatus, applicants disagree with the implication. The implication appears to be that the claims no longer are directed to a gaming method and gaming machine. However, applicant notes that claim 45 recites “[a] *gaming* method for an apparatus including a plurality of reels. . .” and claim 55 recites “[a] *gaming* apparatus.” It should be clear, despite the use of apparatus instead of machine, the newly submitted claims are for gaming.

Further, as to the second allegation that claims 45-88 do not require generation and display of a partial outcome, applicant notes that while the term “partial outcome” is not recited in the claims, the subject matter of the claims includes the generation and display of

less than all of the reels – the “partial outcome.” In this regard, applicant notes that, for example, claim 45 recites “a plurality of reels, each of the reels having a plurality of positions associated therewith in which indicia may be displayed.” Further, applicant notes that the claim continues on to recite “displaying indicia in at least one position associated with a first group of the plurality of reels, the first group defined as fewer than all of the plurality of reels.” Moreover, applicant notes that the claim also recites “displaying indicia in at least one position associated with a second group of the plurality of reels, the second group defined as those reels not in the first group.” Thus, claim 45 provides for display of less than all of the reels (the first group – a “partial outcome”) and then display of all of the reels (both the first and second groups – a “final outcome”). Similar comments can be made relative to claim 55.

Therefore, applicant submits that claims 45-88 are not directed to non-elected subject matter, that claims 45-88 should not be withdrawn from consideration, and that the Amendment of April 13, 2004 is fully responsive to the prior Office Action.

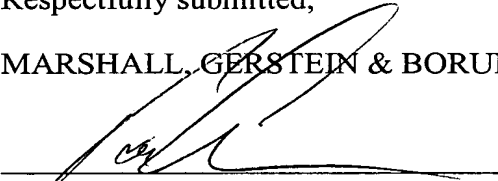
In view of the foregoing and the April 13 Amendment, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is requested to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

Date: August 12, 2004

By:



Paul C. Craane  
Registration No. 38,851  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300